

REMARKS

Applicants have amended claims 1, 13, and 16, and canceled claim 17 without prejudice to or disclaimer of subject matter therein. No new matter has been added by way of these amendments. In view of these amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The Office has rejected claims 13 and 14 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office asserts claim 13 is listed as dependent on cancelled claim 12, and claim 14 depends from claim 13. Accordingly, claim 13 has now been amended to depend from claim 1. In view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw this rejection.

The Office has rejected claims 1-5, 7-11, 13, 16-22, and 24-29 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,222,942 to Bader (Bader), and claims 6, 14, 15, 23, and 30 under 35 U.S.C. §103(a) as allegedly being unpatentable over Bader in view of U.K. Patent Application No. GB 2203047 to Banks (Banks).

With respect to claims 1, 7, 16, 18, and 24, the Office asserts Bader discloses a disabling system for a syringe (citing syringe 1) comprising a plunger (citing plunger rod 13) having two ratchets (citing serration 27) disposed longitudinally along the plunger (citing Figure 6) and a collar (citing stopping collar 19) mountable to a barrel (citing cylinder 2) of said syringe, said collar comprising an inner member (citing clamping tongue 41) and an outer member (citing check tongues 22) incapable of rotation relative to each other (citing col. 5, line 58 – col. 6, line 3, asserting since the tongue 41 is designed integrally with the collar 19, it will not be capable of rotating with respect to the outer member) having at least one pawl (citing catches 23) capable of engaging said ratchet (citing Figure 6), said inner member operable to prevent engagement of said ratchet by the pawl until the plunger is depressed (citing col. 5, line 58 – col. 6, line 9).

With respect to claim 15, the Office asserts Bader discloses a syringe (citing syringe 1) comprising a barrel (citing cylinder 2) that comprises two pawls (citing catches 23); and a plunger (citing rod 13) comprising two opposed ratchets (citing

serrations 23) that engage the pawls to prevent withdrawal of the plunger after plunger depression (citing col. 4, lines 46-55); and a collar (citing collar 19) having an inner member (citing clamping tongue 41) and outer member (citing check tongue 22) incapable of rotation relative to each other (citing col. 5, line 58–col. 6, line 3, asserting since the tongue 41 is designed integrally with the collar 19, it will not be capable of rotating with respect to the outer member), asserting wherein the outer member has at least two pawls (citing catches 23); mounting the plunger for movement in the barrel with the inner member positioned to prevent engagement of the ratchets and pawls until the plunger is depressed (citing col. 4, lines 7-60; col. 5, line 58 – col. 6, line 9). The Office acknowledges Bader fails to disclose wherein the outer member comprises two fingers and the plunger comprises guide slots that engage. However, the Office asserts Banks teaches a syringe comprising a plunger 4 that has splines 7-10 that lock into guide channels 11-14 in order to prevent rotation of the plunger with respect to the syringe body (citing page 5, lines 1- 6).

Bader and Banks, taken alone or in combination, do not disclose or suggest, “said collar comprising an inner member and an outer member having at least one pawl capable of engaging said ratchet, said inner member operable to prevent engagement of said ratchet by said at least one pawl until said plunger is depressed,” as now recited by amended claim 1, “said collar comprising an inner member and an outer member having at least one pawl, said inner member operable to prevent engagement of said ratchet by said at least one pawl until said plunger is depressed,” as recited by claim 7, “wherein said barrel comprises a collar having an inner member and an outer member that are incapable of rotation relative to each other, said inner member operable to prevent engagement of said ratchet by said two pawls until said plunger is depressed,” as recited by claim 15, “depressing said plunger from a first position at which said at least one pawl is not engageable with said at least one ratchet by at least one projection of the inner member positioned between the at least one pawl and the at least one ratchet to a second position at which said at least one pawl is engageable with said at least one ratchet to prevent withdrawal of said plunger,” as now recited by amended claim 16, “positioning an inner member of a collar which is mountable to a barrel of a syringe to prevent engagement of the at least one ratchet of the plunger by at least one pawl of an outer member of the collar until the plunger is depressed,” as recited by claim 18, or “mounting the plunger for movement in the barrel, the inner member is positioned to prevent engagement of the at least one ratchet by the at least one pawl until the plunger is depressed in the barrel,” as recited by claim 24.

With respect to claims 1, 7, 16, 18, and 24 as noted above, the Office asserts Bader's clamping tongue 41 and check tongues 22 to be same as Applicants' claimed inner and outer members, respectively, and asserts that in col. 4, lines 7-60 and col. 5, line 58-col. 6, line 3, Bader discloses clamping tongue 41 is operable to prevent engagement of said ratchet by the pawl until the plunger is depressed. Applicants respectfully disagree with the Office's assertions. In the cited portions, Bader discloses dispensing with serration 27, asserted by Office to be the claimed at least one ratchet, and replacing serration 27 with clamping tongue 41 integrally formed with at stopping collar 19 (*see*, col. 5, lines 56-60). One end of clamping tongue 41 directly rests on plunger rod 13 (*see*, FIG. 11 and col. 5, line 64, although Bader erroneously refers to clamping tongue 41 as clamping tongue 21 therein). In this configuration, when the plunger rod 13 is pushed into the cylinder, a pressing force is created which urges clamping tongue 41 in an outwardly direction. Thus, clamping tongue 41, by virtue of its resilience and small dimensions, merely acts as a frictional mechanism which is overcome upon application of external force (*see*, col. 5, lines 65-67).

Contrary to the Office's assertion, clamping tongue 41 is not "said inner member operable to prevent engagement of said ratchet by said at least one pawl until said plunger is depressed," as recited by claims 1 and 7 (emphasis added), *at least* because clamping tongue 41 is a replacement to the serration mechanism in Bader, and therefore, because serration 27 is absent when clamping tongue 41 is operating, the question of clamping tongue 41 operating to prevent engagement of a non-existent serration 27 by a pawl of check tongues 22 during depression of plunger rod 13 does not arise at all, assuming that Bader discloses a pawl, as claimed, in the first place. Similarly, Bader does not disclose or suggest "depressing said plunger from a first position at which said at least one pawl is not engageable with said at least one ratchet by at least one projection of the inner member positioned between the at least one pawl and the at least one ratchet to a second position at which said at least one pawl is engageable with said at least one ratchet to prevent withdrawal of said plunger," as now recited by amended claim 16 (emphasis added), "positioning an inner member of a collar which is mountable to a barrel of a syringe to prevent engagement of the at least one ratchet of the plunger by at least one pawl of an outer member of the collar until the plunger is depressed," as recited by claim 18 (emphasis added), or "mounting the plunger for movement in the barrel, the inner member is positioned to prevent engagement of the at least one ratchet by the at least one pawl until the plunger is depressed in the barrel," as recited by claim 24 (emphasis added). Since Bader fails to disclose or suggest at least the

above-noted limitations of claims 1, 7, 16, 18, and 24, Bader does not anticipate claims 1, 7, 18, and 24.

With respect to claim 15, as noted above, the Office asserts that in col. 4, lines 7-60 and col. 5, line 58-col. 6, line 3, Bader discloses clamping tongue 41 is operable to prevent engagement of said ratchet by the pawl until the plunger is depressed. Again, Applicants disagree with the Office's assertions. As argued above with respect to claims 1, 7, 16, 18, and 24, Bader fails to disclose or suggest that the inner member is operable to prevent engagement of the ratchet by the pawls of the outer member when the plunger is depressed. Bader's clamping tongue 41, asserted by the Office to be the claimed inner member of the collar, is in direct contact with the plunger rod and is a replacement to the serrations 27 in Bader. Indeed, nowhere in Bader is it disclosed how the clamping tongue 41 itself can prevent engagement of the catches 23 (asserted by the Office as allegedly same as Applicant's claimed pawl) of check tongue 22 with the serration 27, which serration is non-existent when clamping tongue 41 is operational. Banks too fails to disclose or suggest "wherein said barrel comprises a collar having an inner member and an outer member that are incapable of rotation relative to each other, said inner member operable to prevent engagement of said ratchet by said two pawls until said plunger is depressed," as recited by claim 15 (emphasis added), and thus fails to resolve the deficiencies of Bader.

The Office's attention is respectfully requested to page 5, lines 13-16, for example, where Applicants disclose how the inner member 50 prevents engagement of pawls 42A and 42B of outer member 40 with contacting steps 24A and 24B of ratchet 23. Such a mechanism provides a simple yet novel, robust and inexpensive syringe that is automatically disabled with little or no assistance from the user to prevent or minimize the likelihood of re-use of the syringe. Neither Bader nor Banks achieve a disengagement of the plunger rod using the claimed structure and method of the present invention.

Accordingly, in view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw this rejection of claims 1, 7, 15, 16, 18, and 24. Since claims 2-6, 13, and 14 depend from and contain the limitations of claim 1, claims 8-11 depend from and contain the limitations of claim 7, claims 19-23 depend from and contain the limitations of claim 18, and claims 25-30 depend from and contain the limitations of claim 24, they are distinguishable over the cited references and patentable in the same manner as claims 1, 7, 18, and 24.

In view of all of the foregoing, Applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,

Date: August 26, 2009

/Gunnar G. Leinberg/
Gunnar G. Leinberg
Registration No. 35,584

NIXON PEABODY LLP
1100 Clinton Square
Rochester, New York 14604
Telephone: (585) 263-1014
Facsimile: (585) 263-1600